

REMARKS

Favorable consideration of this Response and Amendment is respectfully requested. Claims 1 and 7 are currently amended, claim 10 is currently canceled and claims 2-6, 8, 9, 11, and 12 are currently unchanged. Accordingly, claims 1-9, 11, and 12 are presented for consideration by way of the present Response and Amendment.

In the Office action dated September 17, 2004, claims 7-12 were rejected under 35 U.S.C. §102, as being anticipated by United States Patent Number 2,435,079 issued to Hotchkin. Also, claims 1-6 were rejected under 35 U.S.C. §103 as being unpatentable over Hotchkin in view of United States Patent Number 3,552,427 issued to Jacobson.

The Applicant respectfully submits that claim 1 is not taught or suggested by either of these references. Claim 1 recites, in relevant part, a one-way nut fastener, comprising a nut body including a side wall that is internally threaded. The Examiner relies upon the combination of Hotchkin in view of Jacobson to reach the conclusion that claim 1 is obvious. Specifically, the Examiner relies upon Hotchkin to teach all of the limitations of claim 1, except for the “internally threaded” limitation, and relies on Jacobson to provide this limitation. The Applicant objects to the Examiner’s combination of references on the grounds that there is no motivation to make such combination.

The subject matter of a patent claim may be rejected, even though the subject matter is not identically disclosed or described in a single prior-art reference, if the subject matter as a whole would have been obvious to one of ordinary skill in the art. 35 U.S.C. § 103. To determine whether claimed subject matter is obvious, the scope and content of the prior art and the differences between the prior art and the claims at issue must be determined. Graham v. John Deere, 383 U.S. 1 (1966). Furthermore, some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, must be provided to modify a reference or to combine references. In re Vaeck, 947 F.2d 488, 493, 20 U.S.P.Q. 2d 1438, 1442 (Fed. Cir. 1991). However, the requisite motivation to combine references may not be derived from the Applicant’s disclosure. MPEP § 2143. The mere fact that the prior art structure could be modified does not make such a modification obvious unless the prior art suggests the desirability of doing so. In re Mills, 916 F.2d 680, 682, 16 U.S.P.Q.2d

1430, 1432 (Fed. Cir. 1990); MPEP § 2143.01. Finally, a proposed modification to a prior-art reference cannot render the prior art invention unsatisfactory for its intended purpose or change the principle of operation of the prior art invention. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984); In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959), MPEP § 2143.01. If the proposed modification destroys the intended purpose or principle of operation of the prior art reference, then there is no suggestion or motivation to make the proposed modification and the teachings of the references are not sufficient to render the claims obvious. Id.

The claims at issue are not obvious because there is not a suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify Hotchkin or to combine the teachings of Hotchkin with Jacobson. Rather, the proposed modification of the prior-art references makes Hotchkin unsatisfactory for its intended purpose.

More specifically, Hotchkin discloses a sheet metal nut 11 for insertion into wood or other similar materials. The sheet metal nut has a central aperture 12 having a boundary that is adapted to distort to engage external threads on a fastener. For example, in some embodiments, such as the embodiment shown in FIG. 1, a plurality of tongues 15 are positioned around the aperture to easily allow the distortion illustrated in FIG. 5. As indicated by the Examiner, Hotchkin does not teach or suggest internal threading for engaging an externally threaded fastener. Additionally, the device taught by Hotchkin relies heavily on its thin sheet metal construction to permit distortion, which is a key aspect of its principle of operation.

Jacobson discloses a valve cap for use with a draincock of a water heater to prevent children from inadvertently removing the valve cap. As noted by the Examiner, the valve cap has internal threading.

The Examiner's proposed notification of Hotchkin's device to include Jacobson's internal threading would destroy the key functionality of Hotchkin's device. Internal threading cannot be stamped into sheet metal. Hotchkin's device would have to be made much thicker to support threads, but a substantial increase in thickness would inevitably decrease the flexibility of the part and its ability to distort. Also, Hotchkin relies on the thin sheet metal construction for rapid and economical fabrication (see Hotchkin col. 1, lines 6-16), both of which may be compromised

by making the part thicker and internally-threaded. Accordingly, to modify Hotchkin as suggested by the Examiner (i.e., to add internal threading), the intended purpose of Hotchkin would be destroyed. As such, there is no motivation to modify Hotchkin as indicated by the Examiner, and Hotchkin cannot render the claimed invention obvious.

In light of the arguments presented, claim 1 is allowable. Claims 2-6 depend from claim 1 and are, therefore, also allowable for the same reasons as claim 1, and also because they contain additional patentable subject matter, which for the sake of brevity is not discussed.

Claim 7 was rejected under 35 U.S.C. §102, as being anticipated by Hotchkin. The Applicant respectfully submits that amended claim 7 is not taught or suggested by Hotchkin.

Amended claim 7 recites the following (underlining added for emphasis):

A one-way nut fastener, comprising:

a nut body including a side wall including an internal attaching mechanism and at least one lobe that extends from the side wall, wherein said at least one lobe has a flat portion that extends substantially radially away from the side wall and has a curved portion that extends from the flat portion back toward the side wall.

As described in greater detail in the specification, some embodiments of the nut body have at least one lobe that extends from the nut body. The lobe has a flat portion that extends in a substantially radial direction away from the side wall. The lobe also has a curved portion that extends from the flat portion back toward the side wall. The flat portion allows rotational forces to be applied to the nut body in one direction. The curved portion prevents rotational forces applied in the opposite direction from rotating the nut body.

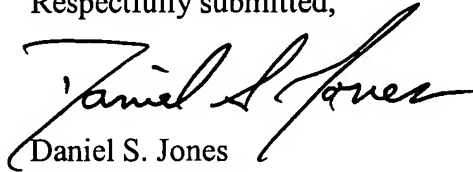
In contrast, Hotchkin does not teach a nut body as recited in amended claim 7. Specifically, Hotchkin does not teach a lobe having a curved portion extending from a flat portion as recited in claim 7. Rather, the lobes 16 of Hotchkin have a flat portion, not a curved

portion, that extends from the first flat portion 18. Therefore, Hotchkin does not teach or suggest the nut body claimed in amended claim 7.

In light of the amendments made and arguments presented, claim 7 is allowable. Claims 8, 9, 11, and 12 depend from claim 7 and are, therefore, also allowable for the same reasons as claim 7, and also because they contain additional patentable subject matter, which for the sake of brevity is not discussed.

In view of the amendments and remarks presented herein, it is respectfully submitted that the claims as amended are in condition for allowance, and notification to that effect is earnestly solicited. The Applicants kindly request that the Examiner telephone the attorneys of record in the event a telephone discussion would be helpful in advancing the prosecution of the present application.

Respectfully submitted,


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